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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,823	10/07/2004	Burkhard Pollak	LUKP:123US	5822

24041 7590 01/30/2007  
SIMPSON & SIMPSON, PLLC  
5555 MAIN STREET  
WILLIAMSVILLE, NY 14221-5406

EXAMINER
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PILKINGTON, JAMES

ART UNIT	PAPER NUMBER *
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3682

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/711,823

Applicant(s)

POLLAK ET AL.

Examiner

James Pilkington

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/04/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 3-9 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. How the shift finger and disengaging elements *operate the gearshift rails* (clm 1 line 3) is critical or essential to the practice of the invention which is not disclosed in either the specification, the claims or the drawings. How do the shift finger and disengaging members operate the gearshift rails? How does the shift finger shift? How do the disengaging members disengage? What do the shift finger and disengaging member communicate with on the shift rails to move them? See paragraph 7 below.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 3-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said shift fingers" in line 9 of the amended claim.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 3-9, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura, USP 4,911,031, in view of Jerwick, USP 6,082,215.

Re clm 1, Yoshimura discloses a gearbox actuator comprising:

- A drive unit (1 or 4)
- A single selector shaft (22)
- Wherein said single selector shaft comprises a shift finger (23) and disengaging elements (sides of 2 and 23, one side is always disengaged from 31-34 when the other side is engaged/pushing the rail forward or back words), said single selector shaft (22) is driven by said drive unit (1 or 4)
- The shift finger (23) and disengaging elements are arranged to operate shift rails (35-38)

Yoshimura does not disclose that the selector shaft and the drive unit are arranged in a gearbox actuator housing and that there is a bearing arrangement formed by protruding rods operatively arranged to support the gearshift rails.

Jerwick teaches that a selector shaft (34) and a drive unit (36) are arranged in a gearbox actuator housing (64/50) and a bearing arrangement formed of protruding rods

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(80 and 82) operatively arranged to support the gearshift rails for the purpose of providing a shift assembly that can be conveniently manufactured and repairable while still maintaining a reliable and durable transmission having an acceptable shift feel (C1/L60-63).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings of Yoshimura and provide for the selector shaft and a drive unit to be arranged in a gearbox actuator housing and a bearing arrangement formed of protruding rods operatively arranged to support the gearshift rails, as taught by Jerwick, for the purpose of providing a shift assembly that can be conveniently manufactured and repairable while still maintaining a reliable and durable transmission having an acceptable shift feel.

Re clm 3, Yoshimura in view of Jerwick discloses that the housing comprises an attachment part (base 50 of Jerwick) operatively arranged to be attached to a gear housing of a gearbox (screwed on, see Figures 2 and 5 of Jerwick) where in the protruding rods protrude through an opening or recess in the gear housing into the gearbox actuator housing (see Figures 5, 6A and 6B of Jerwick).

Re clms 5 and 7, the resulting device of Yoshimura in view of Jerwick would further comprise first and second upper protruding rods and first and second lower protruding rods (each rail of Yoshimura requires a bearing support disclosed by Jerwick), said first and second upper protruding rods arranged opposite/symmetrically opposite each other with respect to the selector shaft, and said first and second lower

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protruding rods arranged opposite/symmetrically opposite each other with respect to the selector shaft.

Re clm 6, Jewick discloses that two protruding rods are provided (80 and 82 of Jewick).

Re clm 8, Yoshimura in view of Jewick discloses all the claimed subject matter above as applied to claim 1.

Yoshimura in view of Jewick, as applied to claim 1, does not disclose that the protruding rods have guide shoe parts at their ends resting against the gearshift rails.

Jewick teaches that the protruding rods (80 and 82) have guide shoe parts (90 and 92) at their ends (90 and 92 are arranged at the ends of the rods 80 and 82) resting against the gearshift rail (the rail 96/inside of shoe 90 and 92 rest against each other) for the purpose of a support that enables for the rail to rotate and translate (C4/L10-13).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings of Yoshimura in view of Jewick and provide for the protruding rods to have guide shoe parts at their ends resting against the gearshift rail, as taught by Jewick, for the purpose of a support that enables for the rail to rotate and translate.

Clms 4 and 9 are product-by-process claims and product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps.

### ***Response to Arguments***

7. Applicant's arguments filed 12/01/06 with respect to the rejection made under 35 U.S.C. 112 1<sup>st</sup> paragraph have been fully considered but they are not persuasive. The applicant cites Holmes, USP 4,584,895, and Norum, USP 7,093,511, as supporting references for the operation of the shift finger and disengaging member. Neither reference cited discloses how the shift finger and the disengaging members of the instant application work. Holmes does not disclose any structure similar to that of the instant application. Norum discloses similar structure to that of the single selector shaft as that of the instant application, however, Norum does not disclose "disengaging members." Norum discloses a primary engagement member (shift finger) and secondary engagement members not "disengaging members". It is still not clear to the examiner how these disengaging members, as claimed, are being used in the device. How do they disengage a shift rail when they are clearly inline with the shift finger? What structure allows them to be "disengaged" at the same time that the shift finger is engaged?

8. Applicant's arguments with respect to the art rejection of claims 1 and 3-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Pilkington whose telephone number is (571) 272-5052. The examiner can normally be reached on Monday-Friday 8:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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1.22.07

  
RICHARD RIDLEY  
SUPERVISORY PATENT EXAMINER